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TRADEMARK

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PATENT

Customer No. 22,852

Attorney Docket No. 04329.3098

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: )  
)  
Yukiteru MATSUI, et al. ) Group Art Unit: 3723  
)  
Application No.: 10/619,480 ) Examiner: Nguyen, Dung V.  
)  
Filed: July 16, 2003 )  
)  
For: POLISHING MEMBER AND )  
METHOD OF MANUFACTURING )  
SEMICONDUCTOR DEVICE )

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

**RESPONSE TO RESTRICTION AND ELECTION OF SPECIES REQUIREMENTS**

In response to the Election of Species Requirement, dated May 11, 2004, with a period for response extending through June 11, 2004, Applicants elect as set forth below.

In the Restriction Requirement, the Examiner required restriction under 35 U.S.C. § 121 between Group I (claims 1 – 9) and Group II (claims 10 – 20). The Examiner required further restriction between two species (characterized by the Examiner as: “species 1 includes figure 1 and species 2 includes figure 11”), with claim 1 being considered by the Examiner as generic to Group I, and claim 10 being considered generic to Group II.

In response, Applicants provisionally elect to prosecute Group II, claims 10 – 20, characterized by the Examiner as “drawn to a method of manufacturing a semiconductor device” (Office Action, p. 2). Further, Applicants provisionally elect to prosecute “Species 1,”

characterized by the Examiner as “includ[ing] figure 1” (Office Action, p. 2), with traverse, and submit that claims 10 – 17, 19, and 20 are readable thereon.

In order to preserve their Right of Petition, Applicants are traversing this Election of Species Requirement, and “distinctly and specifically” point out the errors in said Requirement. *See* M.P.E.P. § 818.03.

Applicants submit that the Examiner erroneously separated the present invention into these two species. Applicants submit that both Figs. 1 and 11 *both* draw support from Applicants’ claimed “polishing member comprising photocatalyst particles that exhibit photocatalysis.” *See* Applicants’ independent claims 1 and 10, for example.

Applicants note that the second of two criteria for a proper Restriction Requirement requires that there “must be a serious burden on the examiner if restriction is required.” *See* M.P.E.P. § 803. Since the Examiner’s Election of Species Requirement only delineates eleven species and required election under 37 C.F.R. § 121, it does not make any mention of why it would be a serious burden upon the Examiner to make this Election of Species Requirement in the first place. The Examiner will not have to commence an additional search to examine Applicants’ claims. Therefore, Applicants submit that the examination of claims 1 – 20 would not pose a serious burden on the Examiner, and accordingly traverse the Examiner’s election of species requirement.

Therefore, Applicants submit that this Election and traversal serve as a “writing which distinctly and specifically points out” the errors in the Examiner’s Election of Species Requirement. *See* M.P.E.P. § 818.03(a). Furthermore, Applicants submit that nothing herein shall be construed as an admission that the claims are not patentably distinct.

It is for these reasons that Applicants make their Election of Species, with traverse.

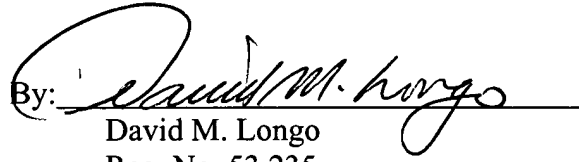
In making the above references to the specification and drawings, it is to be understood that Applicants are in no way intending to limit the scope of the claims to the exemplary embodiments shown in the drawings and described in the specification. Rather, Applicants expressly affirm that they are entitled to have the claims interpreted broadly, to the maximum extent permitted by statute, regulation and applicable case law.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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GARRETT & DUNNER, L.L.P.

Dated: June 3, 2004

By:   
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